

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUTO KOZAKURA
and
TOSHIFUMI SATO

Appeal No. 2004-1227
Application 09/940,311

ON BRIEF

Before GARRIS, WARREN, and WALTZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 and 2, which are all of the claims in the application.

The subject matter on appeal relates to a double-sided meshing type silent chain. With reference to the appellants' drawing (e.g., see Figures 1 and 2 thereof), the chain comprises

a plurality of interleaved rows of link plates 5, 6 articulately connected with one another by connecting pins 7 and having a pair of meshing teeth 2 formed on one side thereof as well as guide plates 8 located outside the row of link plates in the width direction of the chain and having a pair of pin-accommodation holes formed therein, wherein the connecting pins extend through holes in the link plates and are press-fit only in the pin-accommodation holes of the guide plates. Further details of this appealed subject matter are set forth in representative independent claim 1 which reads as follows:

1. A double-sided meshing type silent chain comprising:

a plurality of interleaved rows of link plates articulately connected with one another by connecting pins, each of the link plates having a pair of meshing teeth formed on one side thereof, a flat back face formed on the opposite side thereof, and a pair of pin-accommodation holes for receiving therein a pair of connecting pins, respectively, of the connecting pins;

the link plates in each link plate row being composed of at least one pair of outer link plates disposed in opposite end portions, respectively, in the width direction of the chain, and a plurality of inner link plates disposed in a central portion in the width direction of the chain and disposed between the end portions, the inner and outer link plates being oriented such that the meshing teeth of the inner link plates project from one peripheral side of the chain and the meshing teeth of the outer link plates project from the opposite peripheral side of the chain; and

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guide plates located outside the row of link plates in the width direction of the chain, each of the guide plates having a flat back face formed on one side thereof and a pair of pin-accommodation holes formed therein, each of the pin-accommodation holes of each of the guide plates and each of the pin-accommodation holes of each of the link plates receiving one of the connecting pins, said connecting pins extending through holes in the link plates, and being press-fit only in said pin-accommodation holes of the guide plates.

The prior art set forth below is relied upon by the examiner as evidence of obviousness:

Tada et al. (Tada) 5,803,854 Sep. 8, 1998

The admitted prior art shown in Figures 20 and 21 of appellants' drawing

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art of Figures 20 and 21 of the appellants' drawing in view of Tada.¹

¹ In the paragraph bridging pages 4 and 5 of the answer, the examiner has relied on two prior art references as support for his obviousness conclusion even though these references were not positively included in the examiner's statement of the rejection before us. It is well settled that, where a reference is relied on to support a rejection, whether or not in a minor capacity, the reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3. Also see the Manual of Patent Examining Procedure (MPEP) § 706.02 (J) (Rev. 1, Feb. 2003). Under these circumstances, we will not consider these references in our assessment of the Section 103 rejection advanced on this appeal.

Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning this rejection, we refer to the brief and reply brief and to the answer for a complete exposition thereof.

OPINION

The above-noted rejection cannot be sustained for the reasons set forth below.

It is the examiner's conclusion that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Figures 20 and 21 in view of the teachings of Tada . . . to include guide links having a pair of pin accommodating holes therein so as to improve structural strength and integrity of said chain in at least the longitudinal direction of said chain [answer, pages 3 and 4].

While Tada indeed shows guide links of the type here claimed which are press fit on connecting pins, the sole purpose taught by patentee for these guide links is "to maintain the chain on the sprocket" (column 2, line 43). For the reasons fully explained by the appellants in their Brief, the double-sided meshing type silent chain shown in Figures 20 and 21 of the subject application does not require guide links for the purpose

of maintaining the chain on the sprocket. It follows that the Tada patent contains no teaching or suggestion for utilizing the guide links disclosed therein on the chain of Figures 20 and 21 as proposed by the examiner.

Apparently, the examiner believes an artisan would have been motivated to provide the chain of Figures 20 and 21 with guide links of the type taught by Tada "so as to improve structural strength and integrity of said chain in at least the longitudinal direction of said chain" (Answer, page 4). Significantly, the prior art applied by the examiner contains no evidence that an artisan would have made the provision in question in order "to improve structural strength and integrity" (Id). Instead, it is only the appellants who teach such desiderata with respect to use of guide links of the type here claimed rather than the retainer rings 69 of the Figures 20 and 21 chain (e.g., see pages 7-9 of the subject specification).

Under the circumstances recounted above, it is our determination that the examiner has unwittingly formulated the rejection before us based upon impermissible hindsight derived from the appellants' own disclosure rather than some teaching, suggestion or incentive derived from the applied prior art.

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See W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553,
220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851
(1984). We cannot sustain, therefore, the examiner's § 103
rejection of claims 1 and 2 as being unpatentable over the
admitted prior art of Figures 20 and 21 in view of Tada.

The decision of the examiner is reversed.

REVERSED

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| BRADLEY R. GARRIS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES F. WARREN |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| THOMAS A. WALTZ |) | |
| Administrative Patent Judge |) | |

BRG:svt

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Howson and Howson
One Spring House Corporation Center
Box 457
321 Norristown Road
Spring House, PA 19477